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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,445	01/14/2004	Eric R. Soldan	MS1-1790US	7839
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LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201				
			EXAMINER QUELER, ADAM M	
			ART UNIT 2178	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,445

Applicant(s)

SOLDAN ET AL.

Examiner

Adam M. Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-22 and 24-40 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 and 26-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-16,22,24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed 07/18/2007, Amendment filed 06/15/2007.
2. Claims 1, 3-10, 12-16, 22, 24, and 25 are elected and pending in the case. Claims 1, 10, and 22 are elected independent claims.
3. The rejection of claims 10 and 12-16 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in light of Applicant's remarks.
4. The rejection of claims 1,3-10,12-16,22,24 and 25 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is withdrawn in view of Applicant's remarks.
5. The Claims 10 and 12-16 are rejected under 35 U.S.C. 112 second paragraph is withdrawn in view of Applicant's remarks.

Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/18/07 has been entered.

Election/Restrictions

7. Claims 17-21 and 26-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/12/2006.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 9-10, and 12-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101.

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claim(s) 9-10, and 12-16 define a computer readable medium with descriptive material. A computer readable medium as defined by the specification as including a “modulated data signal, “carrier wave,” or substantially anything. While “functional descriptive material” may be claimed as a statutory product (i.e., a “manufacture”) when embodied on a tangible computer readable medium, a signal or carrier wave embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible “thing”) and therefore does not fall within one of the four statutory classes of § 101. Rather, a “signal” regardless of what is done to the signal, is a form of energy, in the absence of any physical structure or tangible material. Consistent with

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Applicant's specification at paragraph 81, the Office suggests amending "computer readable medium" to "computer storage medium," as this does not include a signal.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1,3-5,7-10,12,13,15,16,22,24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Blair et al. (US 20040133855A1).

Regarding independent claim(s) 1, Blair discloses compiling formatted video content (XHTML and stylesheets, para. 28) into a serialized binary format (para. 7, binary code) that includes layout aspects of the formatted video content (para. 28).

Blair discloses the formatted video content includes a markup language (para. 7). Blair teaches the process is specific to XML (para. 16). Blair teaches that a process that is specific to a predetermined client is used (para. 38). Blair teaches the process renders the video content in the serialized binary format so as to be consistent with the original markup language (para. 36).

Regarding independent claim(s) 10, Blair discloses capturing a presentation result of processed video content (XHTML and stylesheets, para. 28) and creating a serialized binary format (para. 7, binary code). Additionally Blair teaches that the invention is for optimized layout of the original web page. Therefore, inherently, in the normal course of operation Blair will present all

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the original features of the original web page such as layout, rendering, UI interaction, and dynamic aspects.

Blair discloses the formatted video content includes a markup language (para. 7). Blair teaches the format is specific to XML (para. 16). Blair teaches a specific embodiment where only one type of client is used (para. 20). Therefore, the process of that embodiment is specific to that client as it is the only one it contemplates using. Blair teaches the process renders the video content in the serialized binary format so as to be consistent with the original markup language (para. 36).

Regarding independent claim(s) 22, Blair discloses compiling formatted video content (para. 15, information stream, data files) into a serialized binary format (para. 7, binary code) that includes layout aspects of the formatted video content (para. 28). Blair discloses storage for the content (para. 23) and the server does the compilation (para. 22). Blair teaches that the invention is for optimized layout of the original web page. Therefore, inherently, in the normal course of operation Blair will present all the original features of the original web page such as layout, rendering, UI interaction, and dynamic aspects.

Blair discloses the formatted video content includes a markup language (para. 7). Blair teaches the format is specific to XML (para. 16). Blair teaches a specific embodiment where only one type of client is used (para. 20). Therefore, the process of that embodiment is specific to that client as it is the only one it contemplates using. Blair teaches the process renders the video content in the serialized binary format so as to be consistent with the original markup language (para. 36).

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Regarding dependent claim(s) 3, Blair teaches the formatted video content includes source content in one or more language (para. 7). Blair teaches an email format (para. 15).

Regarding dependent claim(s) 4, 12, Blair teaches translating the content in the serialized binary format with DOM into a DOM hierarchy corresponding to the original content (para. 36).

Regarding dependent claim(s) 5, 13, Blair teaches that the invention is for optimized layout of the original web page. Therefore, inherently, in the normal course of operation Blair will present all the original features of the original web page such as layout, rendering, UI interaction, dynamic aspects, form elements, scrolling, navigation and event handling.

Regarding dependent claim(s) 7, 15, 25, Blair teaches XHTML with CSS (para. 32).

Regarding dependent claim(s) 8, 16, in the normal course of operation Blair would inherently come across web sites that contained translated words. As described in claim 1 above Blair would convert content along with those words in to the serialized binary format.

Regarding dependent claim(s) 9, the computer readable medium for performing the method of claim 1 is rejected under the same rationale.

Regarding dependent claim(s) 24, Blair teaches cable (para. 5).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blair.

Regarding dependent claim(s) 6, 14, in the normal course of operation of Blair would encounter web pages that have an inline image and shape in which they are to be placed as these commonly found in web pages. Blair does not specifically recite reflowing such elements consistent with a display resolution and size, however it would have been obvious to one of ordinary skill in the art at the time of the invention to do so as an object of Blair was to adapt the style to the specific display (para. 38), and used reflow to accomplish this goal (para. 55).

Response to Arguments

15. Applicant's arguments filed 06/15/2007 have been fully considered but they are not persuasive.

Regarding Applicant's remarks on the rejections under §101:

Applicant alleges the amendments overcome the rejections, however, the amendments do not appear to alter the interpretation that a computer readable medium can be a signal. Applicant alleges that some proposed functionality makes the claim statutory, but it is not seen how this precludes the interpretation of computer readable medium as a signal, which is not statutory subject matter. Consistent with Applicant's specification at paragraph 81, the Office suggests

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amending “computer readable medium” to “computer storage medium,” as this does not include a signal.

Regarding Applicant's remarks on the rejections under §§102-103:

Applicant’s argument (p. 23, para. 1) is not clear. Blair teaches processing XML. That is the original markup language as described in the claim. Since Blair discloses processing the XML, it must use a process specifically for XML.

Applicant alleges several arguments regarding what is taught by specific embodiment, as it relates to the “predetermined client.” The rejections above now cite para. 38 of Blair, which better illustrates the process is specific to a predetermined client.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



STEPHEN HONG
SUPERVISORY PATENT EXAMINER

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